

**REMARKS**

Claims 6 - 17 have been canceled by this Amendment. A new independent claim 18 and new dependent claims 19 – 24 depending ultimately therefrom have been added. A new independent claim 25 and new dependent claims 26 - 28 depending ultimately therefrom have been added. Claims 18 – 28 are currently pending.

In the Office Action, claims 6-7, 9, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Ueda et al US Patent No. 6,471,313. Also, in the Office Action, claims 6-7, and 9-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saunders et al US Patent No. 2,845,320 in view of Anell et al US Patent No. 6,036,293 and Ueda et al US Patent No. 6,471,313.

Applicants respectfully submit that the rejections of claims 6 – 17 are now moot in view of the cancellation of these claims. Additionally, Applicants respectfully submit that new claims 18 – 28 recite patentable subject matter.

New independent claim 18 of the present application recites a foam-filled hollow body having foam-filled hollow body a first overlay structure, a second overlay, and a destructible layer disposed between the first overlay structure and the second overlay structure. Each of the first overlay structure and the second overlay structure has an opening location and the second overlay structure and the first overlay structure are disposed relative to one another with their opening locations aligned such that an opening formed at the opening location of the second overlay structure would be aligned with an opening formed at the opening location of the first overlay structure along an opening alignment axis.

New independent claim 18 of the present application further recites that the second overlay structure and the first overlay structure form an assembly in which a foam-filled volume can be retained. The destructible layer is, in accordance with new independent claim 18 of the present application, disposed between the first overlay structure and the second overlay structure. As further recited in new independent claim 18 of the present application, the destructible layer extends, relative to the opening

alignment axis, radially between the pair of respective opening locations of the second overlay structure and the first overlay structure and extends further in at least one radial direction to and radially beyond an anchor location radially spaced from the opening alignment axis. The destructible layer has, at the anchor location, a border portion extending in a radial plane relative to an anchor axis completely around the anchor axis and the border portion of the destructible layer is at a radial spacing from the anchor axis.

Continuing further with the recital of a foam-filled body set forth in new independent claim 18 of the present application, the destructible layer has an anchor portion extending radially through the anchor axis and axially offset from the border portion of the destructible layer in an axial offset direction. Additionally, the border portion of the destructible layer is located radially intermediate a border portion of the first overlay structure and a border portion of the second overlay structure. In accordance with new independent claim 18 of the present application, the first overlay structure has an anchor portion that is connected to, and axially offset in the axial offset direction from, the border portion of the first overlay structure and the anchor portion of the destructible layer is located axially intermediate the anchor portion of the first overlay structure and the second overlay structure. The disposition of the destructible layer with the anchor portions and the border portions of the first overlay structure and the second overlay structure is made without substantial heating of at least one of the first overlay structure and the second overlay structure, whereby the destructible layer is secured against any substantial offsetting that would act to uncover the destructible layer from its disposition between the pair of respective opening locations of the second overlay structure and the first overlay structure.

It is respectfully submitted that the foam-filled body set forth in new independent claim 18 of the present application is not taught or disclosed by the prior art of record, either alone or in combination with one another. For example, Ueda et al US Patent No. 6,471,313 discloses a sponge rubber sheet 51 attached to the backside of a reinforcement 14 and the sheet 51 is disposed between the reinforcement 14 and a wall

such that the sheet 51 covers a wall opening 56 and a reinforcing part hole 55. However, it can clearly be seen that Ueda et al US Patent No. 6,471,313 does not teach or disclose, as recited in new independent claim 18 of the present application, a destructible layer having an anchor portion extending radially through an anchor axis and axially offset from a border portion of the destructible layer in an axial offset direction. Instead, the sponge rubber sheet 51 of the Ueda et al US Patent No. 6,471,313 arrangement does not comprise such an anchor portion or a border portion.

Saunders et al US Patent No. 2,845,320 merely discloses a refrigerating appliance and does not teach or disclose a destructible layer. The Office Action proposes that one of skill in the art would be motivated to combine Saunders et al US Patent No. 2,845,320 with Anell et al US and further with Ueda et al US Patent No. 6,471,313. However, Anell et al US Patent No. 6,036,293 discloses (with reference to FIGS. 1, 3 and 4 thereof, which depict a refrigerator cabinet 2 during various stages of assembly) the manner in which a cabinet shell 5, a reinforcing frame unit 7, and a toe plate 9 are united to form a refrigerator cabinet 2. Once a cabinet shell 5 and a reinforcing frame unit 7 are individually constructed, the reinforcing frame unit 7 is slid within receiving slot 58. Thereafter, the reinforcing frame unit 7 is preferably crimped or clinched to cabinet shell 5.

It is well settled that almost all claimed inventions are but novel combinations of old features. The courts have held in this context, however, that when "it is necessary to select elements of various teachings in order to form the claimed invention, we ascertain whether there is any suggestion or motivation in the prior art to make the selection made by the applicant". Interconnect Planning Corp. v. Feil, 227 USPQ 543, 551 (Fed. Cir. 1985) (emphasis added). "Obviousness can not be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination". In re Bond, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990). "Under Section 103 teachings of references can be combined only if there is some suggestion or incentive to do so." ACS Hospital Systems, Inc. v. Montefiore Hospital et al., 221 USPQ 929, 933, 732 F.2d 1572 (Fed.

Cir. 1984) (emphasis original). "Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be 'clear and particular.'" Winner Int'l Royalty Corp. v. Wang, 53 USPQ2d 1580, 1587, 202 F.3d 1340 (Fed. Cir. 2000) (emphasis added; citations omitted); Brown & Williamson Tobacco Corp. v. Philip Morris, Inc., 56 USPQ2d 1456, 1459 (Fed. Cir. Oct. 17, 2000).

In establishing a *prima facie* case of obviousness, it is incumbent upon the Examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion, or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the applicants' disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir. 1988), *cert. den.*, 488 U.S. 825 (1988).

Applicants respectfully believe that any teaching, suggestion, or incentive possibly derived from the prior art of record is only present with hindsight judgment in view of the present application. "It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps. . . . The references themselves must provide some teaching whereby the applicant's combination would have been obvious." In re Gorman, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (emphasis added).

A critical step in analyzing the patentability of claims pursuant to 35 U.S.C. § 103 is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall

victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." Id. (quoting W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983)).

Most if not all inventions arise from a combination of old elements. See In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See id. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See id. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the appellant. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 163.5, 1637 (Fed. Cir. 1998); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. See In re Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. See WMS Gaming, Inc. v. International Game Tech., 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999). The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. See In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981) (and cases cited therein). Whether the examiner relies on an express or an implicit showing, the examiner must provide particular findings related thereto. See In re Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. Broad conclusory statements standing alone are not "evidence." Id. When an Examiner relies on general knowledge to negate patentability, that knowledge must be articulated and placed on the record. See In re Lee, 277 F.3d 1338, 1342-45, 61 USPQ2d 1430, 1433-35 (Fed. Cir. 2002).

New dependent claims 19 – 24 depending ultimately from claim 18 are submitted to be allowable for at least the reasons set forth above with respect to claim 18. Additionally, it is respectfully submitted that new independent claim 25 of the present application is also allowable for at least the reason that new independent claim 25 recites a refrigerating appliance having a housing, a foam-filled volume, and an attachment element, wherein the housing of the refrigerating appliance comprises the features of the foam-filled body set forth in new independent claim 18 of the present application. Moreover, it is respectfully submitted that new dependent claims 26 - 28 depending ultimately from new independent claim 25 are allowable for at least the reasons set forth above with respect to claim 25.

#### **CONCLUSION**

In view of the above, entry of the present Amendment and allowance of the pending claims are respectfully requested. If the Examiner has any questions regarding this amendment, the Examiner is requested to contact the undersigned. If an extension of time for this paper is required, petition for extension is herewith made.

Respectfully submitted,



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